



Important Note Regarding Designating Canada in Madrid System Filings

January 6, 2020

Since June 17, 2019, it has been possible to designate Canada when filing international applications or territorially extending existing international registrations through the Madrid System. Once the Canadian Intellectual Property Office (“CIPO”) receives the request for extension of trademark protection to Canada, the application is treated, for all intents and purposes, as if it had been filed directly in Canada. As such, Canadian **Trademarks Regulations** regarding communications between an applicant and CIPO apply.

While the Regulations permit an applicant to be self-represented, should the applicant wish to appoint any other person to represent them before CIPO, that person must be a trademark agent, defined in the Regulations as a person whose name is on the list of trademark agents maintained by CIPO – namely a resident of Canada who has passed the Canadian trademark agent qualifying examination, or a resident of another country authorized to act as a trademark agent under the law of that country, and who has maintained their status on the CIPO list. If that agent does not reside in Canada, a Canadian-based agent must be appointed as an associate trademark agent.

The Regulations apply to all applications, including territorial extensions to Canada under the Madrid Protocol. As a courtesy, CIPO is currently writing to any representative identified in the request for territorial extension, advising that all communications, which include examination letters, opposition correspondence and registration confirmation, will be sent to the applicant ONLY, and not to the representative who acted in making the request for territorial extension through the World Intellectual Property Office, unless that representative is also a Canadian trademark agent who resides in Canada.

It is advisable to appoint a Canadian trademark agent as soon as possible after giving notice of the request to extend protection to Canada under the Madrid Protocol to ensure that applicants receive all CIPO and third-party communications relating to the Canadian extension application, and that they are fully aware of the implications of such correspondence and pertinent deadlines. In addition, Canadian agents can advise on all aspects of trademark clearance, use and registrability. Ideally, a Canadian agent should be appointed before a Canadian designation is made, to provide helpful tips that may make registration more successful and cost-effective.

Failure to promptly appoint a Canadian trademark agent could put an application at risk. Bereskin & Parr’s Trademark practice group has the expertise to advise you before and after filing in Canada. We would be pleased to appoint our firm as agent on your Madrid Protocol filings, and to assist in securing rights in Canada in the most expeditious manner.

For more information, please contact any member of the [Trademark practice group](#), or at info@bereskinparr.com.

Information on this website is for information only. It is not, and should not be taken as, legal advice. You should not rely on, or take or not take any action, based upon this information. Professional legal advice should be promptly obtained. Bereskin & Parr LLP professionals will be pleased to advise you.